

Amendment

U.S. Patent Application Serial No. 09/725,850

REMARKS

Claims 19 - 22, 25 - 34 and 37 - 42 have been amended.

Claims 24 and 36 have been canceled without any prejudice or disclaimer of the subject matter thereof.

Claims 43 and 44 have been added.

Claims 1 - 23, 25 - 35 and 37- 44 are pending in the subject application.

With respect to the claim amendments, claims 19 and 31 have been amended to recite the features of the card being configured in the form of a non-circular business type card and for direct insertion into a personal computer drive for transfer of information between the card and the personal computer (e.g., as supported by specification sections: Column 4, lines 13, 26 and 32; and Column 9, line 2). These claims have been further amended to enhance readability where the term "storing" (Claims 19 and 31) has been changed to "to store" and the term "facilitating" has been changed to "facilitate" (Claim 19).

Claims 20, 26, 32 and 38 have been amended to recite the feature of the storage medium configured to store data over substantially the entire area of the card (e.g., as supported by specification section Column 4, line 22).

Claims 21 and 33 have been amended for consistency with their amended parent claims and to recite the feature of the data card having the shape selected from the group of a polygon and an ellipse (e.g., as supported by Figs. 1A and 1D and specification section Column 4, line 46).

Claims 22, 28, 34 and 40 have been amended for consistency with and to claim dependency directly from independent claims 19, 25, 31 and 37, respectively (e.g., as supported by Fig. 1C and

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specification section Column 4, lines 42, 46).

Claims 25 and 37 have been amended to recite the feature of the storage medium including and storing the data within a data storage area including a non-circular configuration (e.g., as supported by specification sections: Column 4, lines 22, 42 and 46; Column 9, lines 18 - 24). These claims have been further amended to enhance readability where the term "storing" has been changed to "to store" and the term "facilitating" has been changed to "facilitate". Dependent claims 27, 29, 39 and 41 have been amended for consistency with independent claims 25 and 37 (e.g., as supported by Figs. 1A, 1C and 1D and specification sections: Column 4, lines 22, 42 and 46; and Column 9, lines 18 - 24).

Claims 30 and 42 recite the feature of the card directly inserted into the drive for transfer of information between the card and the personal computer (e.g., as supported by specification section Column 9, line 2).

New claims 43 and 44 include subject matter similar to claims 19 and 25, respectively, and recite the feature of computer readable storage means (e.g., as supported by Figs. 1A, 1C and 1D, Abstract and specification sections: Column 4, lines 13, 26, 32 and 46 and Column 10, line 36).

In the Office Action dated August 28, 2001, the Examiner has indicated that the application lacks an Abstract on a separate sheet, has indicated that the original patent must be received prior to allowance, has indicated that claims 1 - 18 are allowable over the prior art, has indicated that the reissue oath/declaration is defective, has rejected claims 1 - 42 based upon a defective reissue declaration, has rejected claims 19 - 42 under 35 U.S.C. §112, first paragraph, has rejected claims 22, 28, 34 and 40 under 35 U.S.C. §112, second paragraph, has rejected claims 19 - 22, 24 - 26, 28,

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30 - 34, 36 - 38, 40 and 42 under 35 U.S.C. §102(e), has rejected claims 19, 22 - 25, 28 - 31, 34 - 37 and 40 - 42 under 35 U.S.C. §102(b) and has rejected claims 27 and 39 under 35 U.S.C. §103(a). Favorable reconsideration of the subject application is respectfully requested in view of the following remarks.

Initially, Applicants gratefully acknowledge the courtesies extended by the Examiner during a telephone discussion. The discussion focused on the rejections under 35 U.S.C. §112, first paragraph. Applicant cited several sections of the specification providing support for the claimed storage medium feature. The Examiner indicated that these citations would be taken into consideration. The Examiner further indicated that claims reciting means language for the storage medium presented a strong likelihood of overcoming this rejection.

The Examiner alleges that the subject application does not contain an Abstract on a separate sheet as required by 37 C.F.R. §1.72(b). However, the Examiner's attention is directed to 37 C.F.R. §1.173(a)(1). This section states that the entire specification of the patent for which a reissue is requested must be furnished in the form of a copy of the printed patent. Since Applicant has complied with this requirement, the Abstract has been provided on a separate sheet by virtue of the printed patent. In other words, the submitted printed patent provides the Abstract on the first or cover page which is separate from the specification. Accordingly, the application is considered to comply with the Abstract requirement.

The Examiner has rejected claims 19 - 42 under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of

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the claimed invention, and in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. The Examiner takes the position that claims 19 - 42 set forth a "storage medium" rather than a magnetic medium and as a result would cover mediums such as an optical medium, an aspect for which the original disclosure does not provide support. The Examiner applies similar rationale to further indicate that the reissue oath/declaration is defective and to reject claims 1 - 42 under 35 U.S.C. §251 as being based upon a defective reissue declaration.

These rejections are respectfully traversed since the specification provides adequate support for storage mediums other than a magnetic storage medium. Initially, the present invention is directed toward a personal computer data card and method for transferring information between the card and a personal computer. This present invention concept is indicated in the title of the application and the preamble of originally filed claim 1. In other words, the purpose of the present invention is to provide a card or disk that may be utilized simultaneously as both a data storage device and a business card or other type of advertisement media (e.g., See specification Column 4, lines 32 - 36 and Column 5, lines 1 - 5). The particular type of storage media employed by the card is not essential and, in fact, the specification supports various modifications to the cards indicating this aspect and use of other storage mediums. In particular, the specification indicates that the disclosed embodiments are exemplary of the personal computer data card or disk of the present invention (e.g., See specification Column 4, lines 6 - 8). Further, the specification states that the disclosed embodiments represent only a few of the many ways of implementing the personal computer data card or disk (e.g., See specification Column 9, lines 62 - 65). In addition, the

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specification discloses that the personal computer data card or disk “may be applied for use with various types of floppy or other disk drives” (e.g., See specification Column 10, lines 36 - 38). Thus, the specification clearly indicates that the cards may be employed with various computer drives (e.g., CD, DVD, etc.) other than floppy (or magnetic media) disk drives and, therefore, may include various storage media (e.g., optical) compatible with those other drives. Since the specification supports the claimed subject matter as discussed above, claims 19 - 42 are considered to comply with 35 U.S.C. §112, first paragraph. Accordingly, the reissue declaration is considered to be proper, while claims 1 - 42 are considered to comply with 35 U.S.C. §251. Claims 1 - 18 have been indicated as allowable over the prior art and are considered to be in condition for allowance.

The Examiner has rejected claims 22, 28, 34 and 40 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner takes the position that the recitation of the data storage card being substantially rectangular contradicts the feature within the parent claims of the data card configured as one of a number of shapes including a polygon. Applicant respectfully traverses this rejection. Since a polygon is generally a figure bounded by three or more line segments, this term clearly includes a rectangle. Thus, the recitation of the data card being substantially rectangular in each of claims 22, 28, 34 and 40 is not contradictory, but rather provides a further limitation. However, in order to expedite prosecution of the subject application, claims 22, 28, 34 and 40 have been amended to be dependent upon claims 19, 25, 31 and 37, respectively. Accordingly, these amended claims are considered to comply with 35 U.S.C. §112, second paragraph.

The Examiner has rejected claims 19 - 22, 24 - 26, 28, 30 - 34, 36 - 38, 40 and 42 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,579,296 (Smith et al.). This rejection is

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respectfully traversed. Briefly, the Smith et al. patent discloses an optically readable data storage medium including a thin film data carrier fabricated from first and second juxtaposed plastic layers. An adaptor temporarily receives and supports the thin film data carrier from below and includes a centrally located aperture geometrically compatible with a standard CD player spindle to enable the adaptor to be supported and rotated by the spindle. The data storage medium may be configured as a trading card.

In contrast, the present invention is directed toward a personal computer data storage card including a substrate layer, a storage medium layer and a protective layer. Paper may be utilized as the protective layer and include text or graphics to have the data storage card simultaneously function as both a data storage device and a business card or other advertisement media. The storage card is placed within a computer drive, and during rotation therein, traverses read/write members for information storage and retrieval. The data storage card may be of any shape.

The Examiner takes the position that the Smith et al. patent discloses a data card to be read by a standard CD player wherein the card includes visual information thereon and optically encoded digital data to be read by the CD player. The Examiner further alleges that the data card is rotated about an axis perpendicular to and passing through the data card.

However, independent claims 19 and 31 have been amended to recite the features of the card being configured in the form of a non-circular business type card to advertise and provide information pertaining to a business or product to card recipients and for direct insertion into a personal computer drive for transfer of information between the card and the personal computer. The Smith et al. patent does not disclose, teach or suggest these features. Rather, the Smith et al.

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patent discloses a data storage medium attached to a card that requires an adaptor geometrically compatible for use with a conventional CD player in order to enable the CD player to access stored information (e.g., See Column 5, lines 30 - 36 and 57 - 67). In other words, the card of Smith et al. requires an adaptor and, therefore, is incapable of being directly inserted into the CD player as recited in the claims. In addition, the Smith et al. patent discloses that the adaptor has a circular configuration and provides no disclosure, teaching or suggestion of any other adaptor configuration. Thus, even assuming that the data storage medium combined with the adaptor of Smith et al. may be construed as a single data card for direct insertion into a drive of a personal computer, there is no disclosure, teaching or suggestion in Smith et al. that the combined data storage medium and adaptor have or form a single data card with a non-circular configuration as recited in claims 19 and 31.

Claims 25 and 37 have been amended to recite the feature of the storage medium including and storing the data within a data storage area including a non-circular configuration. The Smith et al. patent does not disclose, teach or suggest these features. Rather, the Smith et al. patent discloses a data storage area or data carrier defined by a circular perimeter (e.g., See Figs. 1 and 29 and Column 6, lines 14 - 17). Thus, since the Smith et al. patent does not disclose, teach or suggest the features recited in independent claims 19, 25, 31 and 37 as discussed above, these claims are considered to be in condition for allowance.

Claims 20 - 22, 26, 28, 30, 32 - 34, 35, 38, 40 and 42 depend, either directly or indirectly, from claims 19, 25, 31 and 37, and include all of the limitations of their parent claims. These dependent claims are considered to be in condition for allowance for substantially the same reasons discussed above in relation to their parent claims and for further limitations recited in the dependent

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claims.

The Examiner has rejected claims 19, 22 - 25, 28 - 31, 34 - 37 and 40 - 42 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,916,687 (Endo). This rejection is respectfully traversed. Briefly, the Endo patent discloses a card-like optical information recording medium comprising a card-like base body and concentric or spiral information tracks provided on the base body and capable of optically recording and/or reproducing information thereon. In addition, an apparatus for recording and/or reproducing information on such a card-like medium includes a turn table rotatable with the card-like medium being placed thereon, a clamp mechanism for positioning and fixing the card-like medium on the turn table, and an optical head for applying a light beam to the card-like medium while moving radially of the rotation.

In contrast, the present invention is directed toward a personal computer data storage card as described above.

The Examiner takes the position that the Endo patent discloses a rectangular data card which may have visual information and optically encoded information thereon. The Examiner further alleges that the data card is receivable in a drive which rotates the data card about an axis perpendicular to the data card and which passes through the data card, and that the data card includes curved outer edge portions which are used for alignment purposes.

However, independent claims 19 and 31 recite the features of the card being configured for direct insertion into a personal computer drive for transfer of information between the card and the personal computer as described above. The Endo patent does not disclose, teach or suggest these features. Rather, the Endo patent discloses a specific apparatus for receiving the optical card and

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recording and/or reproducing information thereon. Thus, there is simply no disclosure, teaching or suggestion that the optical card may be used with a personal computer as recited in the claims.

Independent claims 25 and 37 recite the features of the storage medium including and storing the data within a data storage area including a non-circular configuration as described above. The Endo patent does not disclose, teach or suggest these features. Rather, the Endo patent discloses the card data storage or recording area as a circular ring (e.g., See Figs. 3, and 5 - 12; Column 3, lines 38 - 40). There is simply no disclosure, teaching or suggestion of any other geometric configurations of this recording area. Since the Endo patent does not disclose, teach or suggest the features recited in independent claims 19, 25, 31 and 37 as discussed above, these claims are considered to be in condition for allowance.

Claims 22 - 23, 28 - 30, 34 - 35 and 40 - 42 depend, either directly or indirectly, from claims 19, 25, 31 and 37 and, therefore, include all the limitations of their parent claims. These dependent claims are considered to be in condition for allowance for substantially the same reasons discussed above in relation to their parent claims and for further limitations recited in the dependent claims.

The Examiner has rejected claims 27 and 39 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,579,296 (Smith et al.) or U.S. Patent No. 4,916,687 (Endo). This rejection is respectfully traversed. Briefly, the Smith et al. patent is directed toward an optically readable data storage medium as described above, while the Endo patent is directed toward a card-like optical information recording medium as described above.

In contrast, the present invention is directed toward a personal computer data storage card as described above.

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The Examiner takes the position that neither patent expressly discloses the data card in the form of a polygon or ellipse, but that it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the data card of the Endo or Smith et al. patent to be a polygon or ellipse since one of ordinary skill in the art would have recognized that utilizing a shaped space in an adaptor or a turn table would have allowed freedom of shape as the shaped space could be made to conform to the desired shape of the card and the Smith et al. patent discloses an awareness of utilizing various desired shapes.

Initially, claims 27 and 29 depend from claims 25 and 37, respectively, and, therefore, include all of the limitations of their parent claims. As discussed above, the Smith et al. and Endo patents, do not disclose, teach or suggest, either alone or in combination, the features of the storage medium including and storing the data within a data storage area including a non-circular configuration as recited in the claims. Although the Smith et al. patent discloses that the thin film product perimeter may be configured in different shapes (e.g., See Column 10, lines 6 - 9), the product data storage area has a circular configuration (e.g., See Fig. 29 and Column 6, lines 14 - 17; product 10 perimeter is an animal head, while perimeter 44 of the product data storage area has a circular configuration) as opposed to a non-circular configuration as recited in the claims. Since the Smith et al. and Endo patents do not disclose, teach or suggest, either alone or in combination, the features recited in claims 27 and 39, these claims are considered to be in condition for allowance.

In addition to the foregoing, there is no reason to combine the teachings of the Smith et al. and Endo patents. Briefly, the Smith et al. patent is directed toward an optically readable data storage medium for a CD player as described above, while the Endo patent is directed toward a card-



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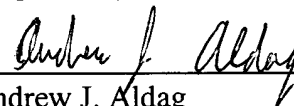
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like optical information recording medium as described above. In contrast, the present invention is directed toward a personal computer data storage card as described above. Since the Endo patent requires a specific apparatus to access the card storage medium, while the media disclosed in the Smith et al. patent require adaptors for and are intended for CD players, there is no reason or motivation to combine the configurations of the Smith et al. media with the Endo medium other than prohibited hindsight derived from Applicant's own disclosure. Further, there is no reason or motivation to modify these patents to obtain the claimed invention. Accordingly, the Smith et al. and Endo patents, either alone or in combination, do not render the claimed invention obvious.

New claims 43 and 44 recite features similar to those within independent claims 19 and 25 and are similarly considered to be in condition for allowance.

The application, having been shown to overcome issues raised in the Office Action, is considered to be in condition for allowance and a Notice of Allowance is earnestly solicited.

Respectfully submitted,



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